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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR    | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 10/068,574      | 02/05/2002  | Christopher James Brown | 02-440              | 8161             |

7590 04/03/2003

J. Jason Link, Esq.  
Kilpatrick Stockton LLP  
1001 West Fourth St.  
Winston-Salem, NC 27101

EXAMINER

ROWAN, KURT C

ART UNIT

PAPER NUMBER

3643

DATE MAILED: 04/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/068,574

Applicant(s)

BROWN et al.

Examiner

KURT ROWAN

Art Unit

3643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Dec 31, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-33 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

Art Unit: 3643

## DETAILED ACTION

### *Claim Rejections - 35 U.S.C. § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 21- 26, 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tryon.

The patent to Tryon show a decoy which shows a three dimensional goose decoy 11, 15 having photographic detail printed thereon. The body is three dimensional since length, height and depth are depicted. In reference to claims 21, 28, although Tryon uses an adhesive to attach the photograph to the main body, it would have been obvious to employ other means to attach the photographs since the function is the same. In reference to claim 28, Tryon does not disclose making the decoy main body from plastic, but it would have been obvious to employ plastic for its light weight, strength, and corrosion resistance. See *In re Leshin*, 125 USPQ 416 which states that the selection of a known material is based on its suitability for the intended use. Plastic is very suitable for decoys. In reference to claim 22, Tryon does not screen-print the photograph onto the body, but it would have been obvious to screen-print the photo since the function is the same.

Art Unit: 3643

In reference to claim 23, Tryon shows the main body formed from a flexible material since all materials have some degree of flexibility. In reference to claim 24, Tryon shows embossed detail such as the eyes which are animal features. In reference to claim 25, Tryon shows the features of geese and also discloses ducks and states that other game birds are within the scope of the invention in column 2, lines 11-18. In reference to claim 26, Tryon shows the game bird in a resting position. In reference to claim 29, Tryon does not disclose the photographs containing corrections, but it would have been obvious to employ corrections in the photos to make the decoy as realistic as possible.

3. Claims 27, 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tryon as applied to claims 21-26 above, and further in view of Palmer.

The patent to Tryon shows a decoy as discussed above. The patent to Palmer shows a main body 12 with an orifice 44 and a head 14 with a flange 20, 22, 24 that is insertable in the orifice in the main body. The decoy is made from expanded polystyrene which is polymeric material. The main body is shaped like the body of an animal. The main body encloses a volume to define a hollow interior having an orifice 44. In reference to claims 27, 30, it would have been obvious to provide Tryon with a shape as shown by Palmer since merely one equivalent shape is being exchanged for another and the function is the same. See *In re Dailey et al.*, 149 USPQ 47. In reference to claim 31, Tryon shows a head (not labeled), but it would have been obvious to employ plural heads, say for example male and female heads so that an array of decoys could be tailored to the user's preference. See *In re Gazda*, 104 USPQ 400. In reference to claims

Art Unit: 3643

32, 33, Tryon discloses goose and duck shaped main bodies and photos and it would have been obvious to employ other game birds as disclosed by Tryon in column 2, lines 11-18.

### ***Response to Arguments***

4. Applicant's arguments filed Dec. 31, 2002 have been fully considered but they are not persuasive. Applicant's response has overcome the double patenting rejection. As stated in the above rejection, Tryon shows a three dimensional main body 11, 15. To have three dimensions, a body must have height, length and depth. Clearly, Tryon has these elements. The claims should be amended to put in more structure of the body.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 3643

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **KURT ROWAN** whose telephone number is (703) 308-2321.

The examiner can normally be reached on Monday-Thursday from 6:30 a.m. to 5:00 p.m.

The fax phone number for the organization where this application or proceeding is assigned is (703) 306-4195 or (703) 305-3597.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



KURT ROWAN

PRIMARY EXAMINER

ART UNIT 3643

March 31, 2003